

### **REMARKS**

This is a full and timely response to the non-final Office Action mailed October 3, 2008. In the Office Action, claims 1–9 have been rejected as allegedly being indefinite for failing to point out and distinctly claim the subject matter of the invention. Claims 1-9 have also been preliminary rejected as allegedly being obvious.

In the present Response, claims 1, 2, 5 and 6 have been amended and claims 1-9 remain pending in the presently pending patent application.

#### **I. CLAIM REJECTIONS UNDER 35 USC §112**

In the Office Action, claims 1–9 have been preliminarily rejected under 35 U.S.C. §112 as allegedly being indefinite for failing to point out and distinctly claim the subject matter of the invention. Claims 1 and 5 have been amended accordingly.

#### **II. CLAIM REJECTIONS UNDER 35 USC §103**

In the Office Action, claims 1, 4, 5, 6, and 9 have been preliminarily rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. patent number 5,472,274 to Baillie (hereafter, “Baillie”), in view of U.S. patent number 205,486 to Johnson (hereafter, “Johnson”). In addition, claims 2, 3, 7, and 8 have been preliminarily rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Baillie, in view of Johnson, and further in view of U.S. patent number 5,435,256 to Svehaug.

It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

**A. Claim 1**

While the Applicant has amended independent claim 1 to make the claim limitations even more clear, the Applicant would first like to explain why independent claim 1 was already allowable over the prior art, even without amendment.

Independent claim 1, without amendment read as follows:

1. A beverage container including a body member with a top end and a cooling member detachably engageable with said body member, wherein said body member is adapted to hold a beverage, wherein said cooling member is adapted to contain a cooling agent, wherein when said cooling member is engaged with said body member, at least a major portion of said top end of said body member is closed and at least part of said cooling member extends into an interior cavity of said body member, wherein said cooling member includes a vessel member and a top closure member threadedly engageable with each other, wherein **said vessel member is engaged with said top closure member, the volume of the internal cavity of said at least one cooling member is larger than the volume of the vessel member, to thereby allow said coolable agent in said vessel to expand into a cavity of said top closure member upon freezing.**

**(Emphasis Added)**

As the claim presently stands, neither Baillie nor Johnson disclose, teach, or suggest all elements of claim 1. Specifically, claim 1 teaches that the vessel member of

the cooling member is engaged with the top closure member of the cooling member to form an internal cavity having a volume that is larger than a volume of the vessel member. The Office Action relies on Johnson in rejecting this element of claim 1. In preliminarily rejecting claim 1, the Office Action reads, "Johnson teaches that it is known to provide a cooling member wherein the volume of the vessel is less than the volume of the cooling member (see domed portion c)." In reviewing Johnson, it is clear that Johnson does not disclose, teach, or suggest this element of claim 1. Element c in FIG. 1 of Johnson is a cap that slips over a nozzle of a can. In Johnson, referring to FIG. 1, a is the can, b is a nozzle on the inner side of which is formed a thread b' extending down the entire length of the nozzle, c is a cap that slips over the nozzle, and d is an inverted cone shaped hollow plug. The plug is a tapering plug provided with a threaded collar that is adapted to be screwed into the nozzle of the can. Therefore, it is clear that the cap of Johnson is not engageable with the plug, thereby not allowing Johnson to disclose, teach, or suggest that when a vessel member is engaged with a top closure member, the volume of the internal cavity of the at least one cooling member is larger than the volume of the vessel member, to thereby allow said coolable agent in the vessel to expand into a cavity of the top closure member upon freezing.

Even though abovementioned is provided, for purposes of expediting the allowance of the presently pending application, independent claim 1 has been amended as follows.

1. A beverage container including a body member with a top end and a cooling member detachably engageable with said body member, wherein said body member is adapted to hold a beverage, wherein said cooling member is adapted to contain a cooling agent, wherein when said cooling member is engaged

with said body member, at least a major portion of said top end of said body member is closed and at least part of said cooling member extends into an interior cavity of said body member, wherein said cooling member includes a vessel member and a top closure member, **wherein the top closure member has a cavity therein, the vessel member and the top closure being** threadedly engageable with each other, wherein **when** said vessel member is **directly** engaged with said top closure member, the volume of the internal cavity of said at least one cooling member is larger than the volume of the vessel member, to thereby allow said coolable agent in said vessel to expand into the cavity of said top closure member upon freezing, **and wherein the cooling member, including the vessel member threadedly engaged with the top closure member, is removable from the top end of the body member.**

**(Emphasis Added)**

The abovementioned modifications to independent claim 1 even further illustrate the differences between the invention claimed in claim 1 and the prior art. In summary, the Applicant respectfully requests allowance of amended independent claim 1.

**B. Claims 2-4**

Since independent claim 1 is allowable over the prior art of record, its dependent claims 2-4 are allowable as a matter of law, for at least the reason that the dependent claims contain all features/elements/steps of their respective independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

**C. Independent claim 5**

Amended independent claim 5 reads as follows:

5. A method of using a beverage container, including the steps of:
  - (a) providing a body member with a top end, said body member being

adapted to hold a beverage;

(b) providing a cooling member detachably engageable with said body member, said cooling member being adapted to contain a coolable agent and including a vessel member and a top closure member, wherein the top closure member has a top closure cavity therein, the vessel member and the top closure being threadedly engageable with each other, wherein when said cooling member is engaged with said body member, at least a major portion of said top end of said body member is closed and at least part of said cooling member extends into an interior cavity of said body member, wherein when said vessel member is directly engaged with said top closure member, the volume of the internal cavity of said at least one cooling member is larger than the volume of the vessel member, to thereby allow said coolable agent in said vessel to expand into a cavity of said top closure member upon freezing, and wherein the cooling member, including the vessel member threadedly engaged with the top closure member, is removable from the top end of the body member;

(c) introducing said coolable agent into a cavity of said cooling member;

(d) placing said cooling member into a refrigerating apparatus;

(e) retrieving said cooling member from said refrigerating apparatus after said coolable agent is cooled to below the ambient temperature; and

(f) engaging said cooling member with said body member.

Amended independent claim 5 is allowable for at least the same reasons as independent claim 1 is allowable. For this reason, reference should be made to the arguments of amended independent claim 1.

**D. Dependent claims 6-9**

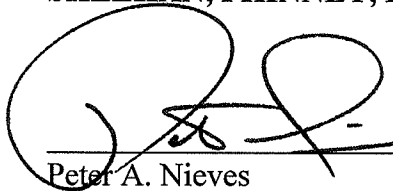
Since independent claim 5 is allowable over the prior art of record, its dependent claims 6-9 are allowable as a matter of law, for at least the reason that the dependent claims contain all features/elements/steps of their respective independent claim 5. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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**CONCLUSION**

In light of the foregoing and for at least the reasons set forth above, the Applicant respectfully requests favorable reconsideration and allowance of the present application and the presently pending claims. If in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited and encouraged to call the undersigned attorney at (603) 627-8134.

Respectfully submitted,  
**SHEEHAN, PHINNEY, BASS + GREEN, P.A.**

A handwritten signature in black ink, appearing to read 'Peter A. Nieves', is written over a horizontal line.

Peter A. Nieves  
Attorney for Applicant  
Registration No.: 48,173